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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,983	01/17/2002	John F. Carver	1823.0440001	3238

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EXAMINER

JEFFERY, JOHN A

ART UNIT PAPER NUMBER

3742

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/047,983

Applicant(s)

CARVER ET AL.

Examiner

John A. Jeffery

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, and 11-13 are rejected under 35 USC 102(b) as being anticipated by EP785750. See transparent electric heater layer 7 and control means responsive to sensed temperature detected by thermocouple 11 in Fig. 1. See *also* col. 3, lines 12-52.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 3, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP785750 in view of JP1-205392. The claims differ from the previously cited prior art in calling for the heater to be coupled to an adjacent surface of

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the electro-optic biometric image capturing device to indirectly heat the object receiving surface. Providing an electric heater on a surface adjacent to a biometric object receiving surface to indirectly heat the same is conventional and well known in the art as evidenced by JP1-205392 noting electric heater 15 disposed on prism surface R adjacent to receiving surface T in Fig. 1. In view of JP1-205392, it would have been obvious to one of ordinary skill in the art to provide an electric heater on an adjacent surface to indirectly heat the receiving surface in the previously described apparatus in order to minimize heating of the object placed on the receiving surface, thereby preventing overheating. With regard to claim 3, no criticality is seen in the control system being within the power source in lieu of separate components as disclosed by EP785750. Furthermore, it is well settled that the recitation that a structure is integral, as contrasted to constituent parts which are rigidly secured together, is merely a matter of obvious engineering design choice. See *In re Fridolph*, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319. See also *In re Lockhart*, 90 USPQ 214 (CCPA 1951), *In re Larson*, 144 USPQ 347, and *Howard v. Detroit Stove Works*, 150 US. 164 (1893). Regarding claim 9, the use of copper and silver for conductive materials is conventional and well known in the art in view of their excellent electrical conductivity and their use does not constitute a patentably distinguishable characteristic of the invention. Regarding claim 10, the use of translucent pads coupled to opposite edges of a heater film is conventional and well known in the art and does not constitute a patentably distinguishable characteristic of the invention.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP785750 in view of Maase (US5825474). The claims differ from EP785750 in calling for the step of removing additional moisture with the heater. EP785750 in col. 2, lines 14-21 states that the purpose of the electric heater is to increase sweat production to improve optical coupling to the surface. While admittedly the purpose of EP785750 is to increase moisture generation from the user's finger, the examiner notes that, given its operating temperature, the electric heater of EP785750 would inherently remove any undesired excess moisture from the platen which would inhibit proper imaging. Notwithstanding the inherent moisture inhibiting properties of the EP '750 heater, the use of electric heaters in conjunction with finger-receiving surfaces to inhibit excess moisture thereon is conventional and well known in the art as evidenced by Maase (US5825474) noting the last line of the Abstract wherein the skin receiving surface is maintained within a selected temperature range to inhibit condensation of moisture from the subject's fingers onto the finger-receiving surface. In view of Maase (US5825474), it would have been obvious to one of ordinary skill in the art to use the heater of EP785750 to inhibit excess moisture from collecting on the finger-receiving surface of the previously described apparatus so that excess moisture was prevented thereby improving imaging.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-205392 in view of Auerswald et al (US5946135). The claims differ from JP1-205392 in calling for first and second heaters coupled to first and second prism ends

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Notwithstanding the inherent moisture inhibiting properties of the EP '750 heater, the use of electric heaters in conjunction with finger-receiving surfaces to inhibit excess moisture thereon is conventional and well known in the art as evidenced by Maase (US5825474) noting the last line of the Abstract wherein the skin receiving surface is maintained within a selected temperature range to inhibit condensation of moisture from the subject's fingers onto the finger-receiving surface. In view of Maase (US5825474), it would have been obvious to one of ordinary skill in the art to use the heater of EP785750 to inhibit excess moisture from collecting on the finger-receiving surface of the previously described apparatus so that excess moisture was prevented thereby improving imaging.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP1-205392 in view of Auerswald et al (US5946135). The claims differ from JP1-205392 in calling for first and second heaters coupled to first and second prism ends

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respectively. While only a single electric heater is attached to the prism in JP1-205392, the use of multiple electric heaters attached to separate ends of a prism to separately heat the respective end is conventional and well known in the art as evidenced by Auerswald et al (US5946135) noting independent electric heaters 8-10 in Fig. 3 which heat separate ends of the prism independently. The independent heating of different prism surfaces facilitates the separate control of each heater's zone independent of the other. See col. 2, lines 50-56. In view of Auerswald et al (US5946135), it would have been obvious to one of ordinary skill in the art to provide independent electric heaters for ends of the prism of JP1-205392 so that separate prism surfaces could be heated independently thereby facilitating a desired heating profile along the prism--either a heating gradient or a uniform heating profile. Regarding claim 19, no criticality is seen in the specific heating control paradigm of three discrete power levels in view of Applicant's own admission in the instant specification on Page 13, paragraph 55 that other thresholds could be used or even eliminated entirely.

#### ***Other Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art should be both separately considered and considered in conjunction with the previously cited prior art when responding to this action.

JP 892, JP 674, JP 675 disclose electric heaters attached to prisms in biometric imaging apparatus. JP 884 teaches heating a prism in a biometric imaging apparatus.

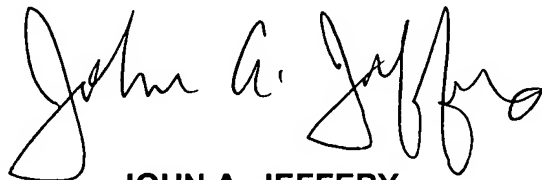
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US 025, US 772, US 127 (see col. 6, lines 48-62) disclose heated prisms. US 259 and US 588 disclose heated transparent articles relevant to the instant invention.

***Conclusion***

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 305-3463. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM EST. The examiner can also be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.

A handwritten signature in black ink, appearing to read "John A. Jeffery". The signature is fluid and cursive, with the first and last names being more prominent.

**JOHN A. JEFFERY  
PRIMARY EXAMINER**

**8/23/02**